



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,200	11/15/2001	Shigefumi Odaohhara	JP920000409US1	4153

25299 7590 06/25/2003

IBM CORPORATION
PO BOX 12195
DEPT 9CCA, BLDG 002
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

LAU, TUNG S

ART UNIT PAPER NUMBER

2863

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/003,200

Applicant(s)

ODAOHHARA, SHIGEFUMI

Examiner

Tung S Lau

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Combination/subcombination

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, 9 and 10, drawn to calculate battery capacity based on power consumption, classified in class 702, subclass 63.
 - II. Claims 7 and 8, drawn to calculate battery capacity based on power consumption and a timer application, classified in class 702, subclass 63.

The inventions are distinct, each from the other because of the following reasons:

Inventions of each of groups I-II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions can each be used for their respective uses has separate utility such as calculate battery capacity based on power consumption and a timer application. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Bruce Schelkopf on 5/30/2003 a provisional election was made **without traverse** to prosecute the invention of group I, claims 1-6, 9 and 10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7 and 8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6, 9, 10, 4, 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukuda (U.S. Patent 6,295,002).

Regarding claim 1:

Fukuda discloses a method of calculating capacity of an intelligent battery equipped with a current measurement circuit to measure an electric current value on which calculation of battery capacity is based (abstract), comprising the steps of: (a) sending, from a system to the intelligent battery, a notice that it shifts to a low electric power consumption mode, and a consumption electric current value or a consumption electric power value in the low electric power consumption mode unique to the system, when the system using the intelligent battery shifts from a normal operational mode to the low electric power consumption mode (Col. 3, Lines 1-32); (b) performing subtraction of capacity data of the intelligent battery based on the received consumption electric current value or consumption electric power value in the low electric power consumption

mode, and disabling capacity calculation by the current measurement circuit (Col. 2, Lines 4763); (c) sending, from the system to the intelligent battery, a notice of shifting to the normal operational mode, and stopping the subtraction of capacity data based on the consumption electric current value or consumption electric power value in the low electric power consumption mode., and enabling capacity calculation by the current measurement circuit, when the system using the intelligent battery shifts from the low electric power consumption mode to the normal operational mode (Col. 3-4, Lines 39-23).

Regarding claim 6:

Fukuda discloses a method of calculating capacity of an intelligent battery equipped with a current measurement circuit to measure an electric current value on which calculation of battery capacity is based (abstract), comprising the steps of: (a) on a shift of the system from a normal operational mode to a low electric power consumption mode and thereafter to the normal operational mode, calculating on the system side consumption battery capacity data assumed to have been spent during the low electric power consumption mode based on a consumption electric current value or a consumption electric power value in the low electric power consumption mode unique to the system (Col. 3, Lines 39-60). (b) sending consumption battery capacity data from the system side to said intelligent battery side (Col. 3-4, Lines 39-15) ; (c) on said intelligent battery side,

calculating current battery capacity based on said consumption battery capacity data (Col. 2, Lines 48-67).

Regarding claim 9, 4, 5:

Fukuda discloses a portable electronic device and method, comprising (a) a first system component for operating with supplied electric power in the normal operational mode but not operating with no supplied electric power in the low electric power consumption mode (Col. 2, Lines 43-67); (b) a second system component for operating with supplied electric power both in the normal operational mode and in the low electric power consumption mode (Col. 11, Lines 47-55); and (c) a controller (fig. 1, unit 43a) for: (i) performing control to supply electric power to said first and second system components, and supply electric power to said second system component and stop supply of electric power to said first system component in the low electric power consumption mode (abstract); (ii) when shifting from the normal operational mode to the low electric power consumption mode, sending to an intelligent battery a notice of shifting to the low electric power consumption mode and also sending a consumption electric current value or a consumption electric power value unique to the system (Col. 3, Lines 38-67) and (iii) when shifting from the low electric power consumption mode to the normal operational mode, sending from the system to the intelligent battery a notice of shifting to the normal operational mode; and said intelligent battery characterized by: (iv) in the low electric power consumption mode, performing subtraction of capacity data based on the

received consumption electric current value or consumption electric power value in the mode, and disabling capacity calculation on the current measurement circuit on the other hand (Col. 2, Lines 43-67) ; (v) when shifting from the low electric power consumption mode to the normal operational mode, stopping the subtraction of capacity data based on the consumption electric current value or consumption electric power value in the low electric power consumption mode, and enabling capacity calculation by the current measurement circuit on the other hand (Col. 2, Lines 43-67) .

Regarding claim 10:

Fukuda discloses a portable electronic device, comprising: (a) a first system component for operating with supplied electric power in a normal operational mode but not operating with no supplied electric power in a low electric a power consumption mode (abstract) (b) a second system component for operating with supplied electric power both in the normal operational mode and in the low electric power consumption mode (Col. 3, Lines 1-35); and (c) a controller for (i) performing control to supply electric power to said first and second system components, and supply electric power to said second system component and stop supply lo of electric power to said first system component in the low electric power consumption mode (Col. 3, Lines 40-67); (ii) when shifting from the normal operational mode to the low electric power consumption mode, sending from a system to an intelligent battery a notice of shifting to la the low electric power

consumption mode and also sending consumption battery capacity data assumed to be consumed during the low electric power consumption mode based on a consumption electric current value or a consumption electric power value in the low electric power consumption mode unique to the second system component calculated on the system side (Col. 3-4, Lines 38-43); and (iii) when shifting from the low electric power consumption mode to the normal operational mode, sending from the system to the intelligent battery a notice of shifting to the normal operational mode; and said intelligent battery characterized by: (iv) performing subtraction of the capacity data based on the received consumption battery capacity data in the low electric power consumption mode, and disabling capacity calculation on the current measurement circuit on the other hand (Col. 2, Lines 47-67) ; (v) when shifting from the low electric power consumption mode to the normal operational mode, stopping the subtraction of capacity data based on the consumption current capacity data in the low electric power consumption mode, and enabling capacity calculation by the current measurement circuit on the other hand (Col. 3-4, Lines 38-43).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph as it fails to particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 contains the trademark/trade name ACPI. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe Advanced Configuration and Power Interface standard specification and, accordingly, the identification/description is indefinite.

Claim Objections

4. Claims 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitation of the base claim and any intervening claims.

Art Unit: 2863

The following is an examiner's statement of reasons for allowance: prior art fail to teach the use of Optional MfgFunction 1 to Optional MfgFunction5 of SBS command.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tung S Lau whose telephone number is 703-305-3309.

The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on 703-308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5841 for regular communications and 703-308-5841 for After Final communications.

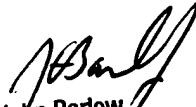
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

TC2800 RightFAX Telephone Numbers : TC2800 Official Before-Final RightFAX - (703) 872-9318, TC2800 Official After-Final RightFAX - (703) 872-9319

TC2800 Customer Service RightFAX - (703) 872-9317

TL

June 17, 2003


John Barlow
Supervisory Patent Examiner
Technology Center 2800